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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,194	09/04/2003	Michael D. Morgan	L3757-04	6855

7590

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EXAMINER

MANAF, ABDUL

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/655,194	<b>Applicant(s)</b> MORGAN ET AL.	
	<b>Examiner</b> Abdul Manaf	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 47-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-66 is/are rejected.
- 7) ☐ Claim(s) 62 and 66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 62 is objected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The new limitations "wall studs" (line 5) and "wall board" (line 6) are claimed. This claim thus appears to be a combination claim which should not depend from a sub combination claim.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The dependant claim 66 fails to indicate the claim it depends upon; it seems like a typographical mistake. A correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent No. 3,805,471 to De Schutter**

In regard to claim 65, De Schutter discloses a fire-resistant barrier comprising a track (Fig. 14: C) having a generally elongate body comprising an H-shaped cross-section (Fig. 14, column 6, lines 54-55). Schutter discloses a track comprising two flanges in Fig. 16: 242. However, Schutter does not disclose the flanges in Figure 14 embodiment. It would have been a matter of design choice to one of ordinary skill in the art to have the flanges for additional structural strength in order to support heavier loads.

The phrase "to attach said H-shape to a building surface" (lines 2-3) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 66, De Schutter discloses a track comprising two flanges in Fig. 16: 242 made from one sheet of metal (column 18, lines 1-4).

**Claims 47 – 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent No. 3,805,471 to De Schutter in view of the U.S. Patent No. 5,356,446 to Smetana et al.**

In regard to claim 47, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having a generally elongate body comprising an H-shaped cross-section (Fig. 14, column 6, lines 54-55) having a channel operative for retaining a filling (column 9, lines 27-30) against a building surface.

The phrase “for retaining a molding barrier bag filled with firestop material against a building surface” (lines 3-4) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

While Schutter discloses an H-shaped track (Fig. 14), Schutter does not disclose a barrier bag operative to be filled with fire-stop material. However, Smetana discloses a barrier bag (Smetana, Fig. 5: 40) operative to be filled with fire-stop material (Smetana, Fig. 5: 28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schutter by using a barrier bag filled with fire-stop

material in order to prevent smoke from passing through the joints and walls consequently preventing a building occupants from suffocation.

In regard to claim 48, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track comprising a channel (Fig. 14: C). While Schutter discloses a track comprising a channel (Fig. 14), Schutter does not disclose a barrier bag located within a channel of the track. However, Smetana discloses a barrier bag (Smetana, Fig. 5: 40) located within a channel of a track (Smetana, Fig. 5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schutter by locating a barrier bag within a channel of a track in order to prevent smoke from passing through the joints and walls, consequently preventing a building occupants from suffocation.

In regard to claim 49, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having two elongate parts.

The phrase "a first part defining said channel for retaining a molding barrier bag and a second part shaped to straddle wall studs" (lines 2-3) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 50, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having two elongate parts attached to each other.

In regard to claim 51, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having an H-shaped cross-section (Fig. 14, column 6, lines 54-55)

In regard to claim 52, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C). Schutter discloses a track comprising two flanges in Fig. 16: 242. However, Schutter does not disclose the flanges in Figure 14 embodiment. It would have been a matter of design choice to one of ordinary skill in the art to have the flanges for additional structural strength in order to support heavier loads.

The phrase "for attaching said track to a building surface and retaining molding barrier bag against the building surface" (lines 2-3) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 53, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) formed from one sheet of metal (column 18, lines 1-4) as clearly shown in Figure 14.

In regard to claim 54, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having a plurality of openings (column 5, lines 41-46). Schutter does not specifically state the openings located periodically along the length of elongate body. However, it would have been a matter of design choice to one of ordinary skill in the art to have the openings located periodically along the length of elongate body in order to reduce material and cost.

The phrase "to permit access filling said molding barrier bag" (lines 2-3) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 55, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having a plurality of openings (column 5, lines 41-46). Schutter does not specifically state the openings located periodically along the length of elongate body, proximate to flanges. However, it would have been a matter of design choice to one of ordinary skill in the art to have the openings located periodically along the length of elongate body, proximate to flanges in order to reduce material and cost.

The phrase "to permit visual inspection of said molding barrier bag when said bag is filled with firestop material" (lines 3-4) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device.



It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 56, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) formed from one sheet of metal (column 18, lines 1-4) having an H-shaped cross-section (Fig. 14, column 6, lines 54-55) wherein the H-shaped cross-section comprises outer vertical walls (Fig. 14: 216) in turn connected to inner vertical walls (Fig. 14: 214) connected to each other by a connecting wall member (Fig. 14: 212). Schutter discloses a track comprising two flanges in Fig. 16: 242. However, Schutter does not disclose the flanges in Figure 14 embodiment.

It would have been a matter of design choice to one of ordinary skill in the art to have the flanges for additional structural strength in order to support heavier loads.

The phrase "for attaching said device to a building surface" (line 3) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 57, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) and a connecting wall member (Fig. 14: 212) having a plurality of openings (column 5, lines 45-46). Schutter does not

specifically state the openings located periodically along the length of elongate body. However, it would have been a matter of design choice to one of ordinary skill in the art to have the openings located periodically along the length of elongate body in order to reduce material and cost.

The phrase "for filling said molding barrier bag" (line 3) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 58, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having a plurality of openings (column 5, lines 41-46). Schutter does not specifically state the openings located periodically along the length of elongate body, proximate to flanges. However, it would have been a matter of design choice to one of ordinary skill in the art to have the openings located periodically along the length of elongate body, proximate to flanges in order to reduce material and cost.

The phrase "to permit visual inspection of said molding barrier bag" (lines 2-3) comprises statement of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate

the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 59, De Schutter in view of Smetana et al. discloses a method for attaching a barrier to a building component (Abstract). Schutter does not disclose placement of a barrier bag within a channel defined by (212) of Figure 14. However, Smetana discloses a method of placing a molding barrier bag within a channel (Smetana, Abstract) against a wall surface (Smetana, Fig. 5: 20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schutter by locating a barrier bag within a channel of a track in order to prevent smoke from passing through the joints and walls, consequently preventing a building occupants from suffocation.

In regard to claim 60, De Schutter in view of Smetana et al. discloses a method for attaching a barrier to a building component (Abstract). The track (Fig. 14) could inherently be assembled with a wall stud. Schutter does not disclose filling a barrier bag. However, Smetana discloses a method of filling a molding barrier bag with a fire-stop material (Smetana, Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schutter by locating a barrier bag within a channel of a track in order to prevent smoke from passing through the joints and walls, consequently preventing a building occupants from suffocation.

In regard to claim 61, De Schutter in view of Smetana et al. discloses a barrier comprising a track (Fig. 14: C) having walls (Fig. 14: 214, 216). The track walls could

inherently be attached with a wall stud; and could inherently be moved with respect to the molding barrier bag retained in the track.

In regard to claim 62, De Schutter in view of Smetana et al. discloses a fire-resistant barrier comprising a track (Fig. 14: C) having an H-shaped cross-section (Fig. 14, column 6, lines 54-55) having a channel operative for retaining a filling (column 9, lines 27-30) against a building surface. The track walls could inherently be attached with a wall stud; and could inherently be moved with respect to the molding barrier bag retained in the track.

The phrases “for attaching said H-shaped cross-sectional profile against a building surface” (lines 1-2) and “to move with thermal cycling” (line 7) comprise statements of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

While Schutter discloses an H-shaped track (Fig. 14), Schutter does not disclose a barrier bag operative to be filled with fire-stop material; and located in an upper channel of the track (Fig. 14). However, Smetana discloses a barrier bag (Smetana, Fig. 5: 40) operative to be filled with fire-stop material (Smetana, Fig. 5: 28), located in a lower channel of the track. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schutter by locating a barrier bag filled with fire-stop material, in an upper channel of a track in order to prevent smoke from

passing through the joints and walls consequently preventing a building occupants from suffocation.

**Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent No. 3,805,471 to De Schutter in view of the U.S. Patent No. 5,890,245 to Klearman et al.**

In regard to claim 63, De Schutter in view of Klearman et al. discloses a barrier comprising thermal barrier comprising a H-shaped track. However, Schutter does not disclose a thermal barrier bag. Klearman disclose a molding bag comprising a first and second faces seamed together by heat welding (column 3, lines 42-46), said molding bag comprises a plurality of pleats (in the deflated state) operative to permit expansion of the bag when said bag is filled.

The phrase "when filled with firestop material" (lines 2-3) comprises statements of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

In regard to claim 64, De Schutter in view of Klearman et al. discloses a barrier comprising thermal barrier comprising a H-shaped track having a plurality of openings (column 5, lines 41-46). However, Schutter does not disclose a thermal barrier bag. Klearman disclose a molding bag comprising a first and second faces seamed together by heat welding (column 3, lines 42-46), said molding bag comprises a plurality of pleats

(in the deflated state) operative to permit expansion of the bag when said bag is filled. Klearman discloses a bag having an opening (Klearman, column 3, lines 36-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schutter by placing and orienting the bag opening with respect to the track opening in order to fill or empty the bag.

The phrase "when filled with firestop material" (lines 2-3) comprises statements of intended use which does not further limit the structure features of the claimed invention, a fire barrier device. It has been held that a recitation regarding the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from a prior art apparatus which satisfies the claimed structural limitations (Ex Parte Masham, 2 USPQ F2nd 1647, 1987).

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdul Manaf whose telephone number is 571-272-1476. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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AM *A-M.*  
12/01/2005



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